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In re Application of SAUER et al
U.S. Application No.: 09/446,128
PCT Application No.: PCT/EP98/03349
Int. Filing Date: 04 June 1998
Priority Date: 04 July 1997
Attorney Docket No.: A-6865
For: PROCESS FOR FURTHER PROCESSING
OF SMALL GLASS PARTICLES

DECISION ON PETITION

UNDER 37 C.F.R. §1.47(a)

This is in response to applicants' "Response to Decision on Petition Under 37 C.F.R. 1.47(a)", filed 04 August 2000, requesting that the present application be accepted for national stage processing without the signature of joint inventor Saroff Sauer. In addition, this decision is in response to applicants' "Submission of Revocation of Attorney / Appointment of New Power of Attorney" filed 25 October 2000.

BACKGROUND

On 04 June 1998, applicants filed international application PCT/EP98/03349, which claimed priority of an earlier German application filed 04 July 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 January 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 January 2000.

On 28 December 1999, applicants filed national stage papers in the United States including, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 03 March 2000, the United States Designated/Elected Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 03 April 2000, applicants filed a petition requesting that the present U.S. national stage application be accepted without the signature of joint inventor Sauer. The petition was accompanied by the requisite petition fee, a declaration signed by joint inventor Christian Klepsch, and the appropriate surcharge under 37 CFR 1.492(e) for the late declaration filing.

On 28 June 2000, the PCT Legal Office dismissed the 03 April 2000 petition on grounds that it failed to demonstrate that a bona fide attempt was made to present a copy of the application papers to Sauer at his last known address and for a lack of sufficient evidence of Sauer's refusal to sign.

On 04 August 2000, applicants filed the present renewed petition. The petition states that it is accompanied by, inter alia, a letter signed by Sauer which evidences Sauer's express refusal to sign the declaration.

DISCUSSION

I. Renewed Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventor, (2) factual proof that the missing joint inventor refuses to join in the application or cannot be reached after diligent effort, (3) the fee set forth in 37 CFR §1.17(i), and (4) the last known address of the nonsigning joint inventor. See 37 CFR 1.47(a).

With regard to item (1), the declaration filed 03 April 2000 is executed by joint inventor Klepsch on his own behalf and on behalf of the nonsigning joint inventor Sauer.

With regard to item (2), MPEP 409.03(d) states,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. . . .

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the application papers (including the specification, claims, drawings, and oath or declaration) to Sauer for signature. The letter signed by Sauer dated 21 July 2000 states that he refuses to sign the declaration and powers of attorney, but provides no evidence that Sauer was presented with a complete copy of the application papers (including the specification, claims, and drawings). The petition similarly makes no mention of the specification, claims, and drawings having ever been presented to Sauer for signature.

It is noted that appendices A-C filed with the present petition have not been translated into English and therefore cannot be considered.

With regard to item (3), applicants have submitted the fee required by 37 CFR 1.17(i).

With regard to item (4), applicants have provided the last known address of Sauer.

II. Revocation and Appointment of Attorney

The "Submission of Revocation of Attorney / Appointment of New Power of Attorney" filed 25 October 2000 is not effective. The assignee has not established that it is the assignee of the entire interest. See MPEP 402.07. The assignment recorded at the frame number provided establishes only that KGT-Klepsch Glastechnologie GmbH has assigned its interest to Starshine Glastechnologie GmbH. The chain of assignment from the inventors Sauer and Klepsch to Starshine Glastechnologie GmbH has not been established. Furthermore, the revocation is signed by Johann Schirmbeck, but there is no indication that Schirmbeck is a corporate officer of Starshine Glastechnologie GmbH. See MPEP 324. Therefore, it is not possible to accept the "Submission of Revocation of Attorney / Appointment of New Power of Attorney" at this time.


CONCLUSION

For the reasons set forth above, the petition under 37 C.F.R. §1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

A handwritten signature in black ink, appearing to read "Leonard Smith", written in a cursive style.

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